

**REMARKS/ARGUMENTS*****Claim Status***

Currently, Claims 8, 9 and 15-24 are pending. Claims 1-7 and 10-14 have been cancelled. Claim 21 has been amended. No new matter has been added.

***Claim Rejections – 35 U.S.C. §112***

The Examiner rejected claim 23 under 35 USC §112 (1<sup>st</sup> para.) for inclusion of a negative limitation, “the intermediate member preventing the gear ring and hub from making direct contact”, not positively recited in the specification. As such, it is unclear whether Applicant had possession of the claimed invention. Applicant traverses. The aforementioned is at least depicted in figure 3. In figure 3, intermediate layer 32 is depicted as being substantially round and having a perimeter extending out from below hub 24 and atop of gear wheel 20 (see also page 5, line 28 to page 6, line 4). Accordingly, the intermediate layer 32 prevents gear wheel 20 and hub 24 from making contact. This is further understood by its function of absorbing the different rotational stress of the two gears, as discussed throughout the specification. For the intermediate layer 32 to function as such, it must physically separate the two (hub 24 and gear wheel 20) otherwise rotational force from one would directly pass to the other resulting in harmful effects which the present invention addresses.

An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). (see MPEP 2163).

Accordingly, by the depiction, Applicant has demonstrated possession and reconsideration and withdrawal of the rejection is respectfully requested.

The Examiner rejected claim 21 under 35 USC §112 (1<sup>st</sup> para.) for lacking antecedent basis in the specification, namely, that “the gear ring and hub are directly joined together by said elastic intermediate layer”. Applicant traverses. The Examiner’s attention is respectfully drawn to at least page 6, line 1 to 11 which discusses the aforementioned. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

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The Examiner rejected claims 23 and 24 under 35 USC §112 (1<sup>st</sup> para.) as lacking antecedent basis in the instant specification. Antecedent basis is considered provided at least on page 2, lines 14-30. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

The Examiner rejected claims 8, 9 and 15-24 under 35 USC §112 (2<sup>nd</sup> para.) because the metes and bounds of the terms "peak torque" are unclear. Claim 21 has been amended above to remove the term "peak". Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

#### ***Claim Rejections – 35 U.S.C. §102***

The Examiner rejected claims 21-24 under 35 USC §102(b) as being anticipated by Becker *et al.* For at least the aforementioned reasons, Applicant traverses.

The present invention is directed to a locking device having elastic intermediate layer 32 located between a hub 24 and a gear wheel 20. The layer 32 is further directly connected to each of the hub 24 and gear wheel 20 via material to material bonding. The intermediate layer functions to absorb peak torque resulting from kinetic energy generated by motor 12 on elements of the locking device such as the hub 24 and wheel 20.

In rejecting the above features, the Examiner noted that Becker discloses a gear ring 34, a hub 36 and an elastic intermediate layer 44. As depicted in Figure 1 of Becker, the gear ring 34 and hub 36 are not both directly joined to intermediate layer 44. Rather, intermediate layer 44 is a lining positioned between drive claws 38 and worm wheel 34. Hub 36 contacts the drive claws rather than the lining.

In further rejecting the above claim, the Examiner noted that Becker's intermediate layer [44] prevents direct contact between the inner radial surface of 32 [teeth of worm wheel 34 – col. 3, lines 13-14] and an outer radial surface 38, as broadly recited;". In contrast, the instant intermediate layer 32 is arranged to prevent direct contact between the instant gear ring (noted by the Examiner as being anticipated by gear ring 34) and instant hub (noted by the Examiner as being anticipated by hub 36) as depicted in figure 3 and set out in amended claim 23. In addition, the instant intermediate layer is directly sandwiched between the gear ring and hub.

In further rejecting the above claims, the Examiner noted that "the intermediate layer 44 allows for uncoupling and coupling, as it initially couples, then should it experience an excessive force, it would shear, thereby uncoupling, as broadly recited (additionally, the intermediate layer 44 inherently absorbs ubiquitously "peak torque"). The function of the lining is set out in col. 3, lines 36-43, namely, to provide a certain amount of elasticity between worm wheel and drive pinion 36 against the shock of a reverse acting force of any kind as well as to suppress vibrations. Applicant is unable to locate any mention within Becker of the intermediate layer/lining 44 allowing for coupling and uncoupling via shearing. Rather, the only mention of the intermediate layer/lining 44 may be found as noted above and in column 5, lines 35-36 (wherein 44' is mentioned). Applicant considers it highly unlikely that Becker intended for its intermediate layer/lining 44 to become sheared during a process of "reverse acting force absorption". Applicant further notes that the instant claims are not directed to the intermediate layer performing a "coupling". Claim 24 is directed to an embodiment of the intermediate layer being a decoupling element arranged to decouple the gear ring and hub. Support for this limitation may be found on page 2, lines 28-30, which recites that if the actuating drive and the movable element are not decoupled, then the excess kinetic energy can be absorbed by means of the decoupling element.

Applicant is unable to identify application of Becker against claim 22.

For at least the above reasons, Becker does not disclose all the limitations of the claims 21-24 and is therefore unavailable as a §102(b) reference. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

#### *Claim Rejection - 35 USC §103*

The Examiner rejected claims 8, 9, 15-19 and 21-24 under 35 USC §103 as being unpatentable over DE 19839707 in view of Becker. For at least the following reasons, Applicant traverses.

The German reference was relied upon as a base teaching which disclosed several claimed elements but for the instant gear ring, hub, elastic intermediate element and arrangements thereof. To provide the missing teachings, the Examiner turned to Becker. As set out above, Becker does not disclose the instant gear ring, hub and elastic intermediate layer as claimed. Accordingly, the combination of

Becker and the German reference does not disclose nor suggest all the claimed elements. Therefore, reconsideration and withdrawal of the rejection is respectfully requested.

*Response to Arguments*

The Examiner maintained his rejection of claim 23, under 35 USC §112, 1<sup>st</sup> paragraph for inclusion of a negative limitation in arguing that:

It is Examiner's contention that the structure as seen in figure 3 is insufficient to support applicant's claim of fully setting forth the claimed invention. At best it is silent to applicant's added limitations, as the internal structural make-up of the hub/intermediate elastic member/ring gear is unknown and unsupported by the original specification.

The antecedent basis for the structure of the hub/intermediate member/gear is disclosed in all of the figures, with figure 3 being an exemplary depiction, as well as in the specification at least on page 6, lines 1-11. Herein, the composition of the aforementioned along with how the aforementioned are bonded is set out in sufficient detail for one skilled in the art to make and use the invention.

The Examiner maintained his rejection of claims 23 and 24 under 35 USC §112, 1<sup>st</sup> paragraph for failing to comply with the written restriction requirement, namely that the disclosure does not provide sufficient antecedent basis for the coupling/decoupling abilities of the hub/elastic element/ring gear assembly, nor does it explicitly state that the intermediate layer prevents direct contact of the hub and ring gear. Applicant respectfully disagrees and notes that, as set out above, the disclosure sufficiently describes the aforementioned and its functionality for one skilled in the art to make and use the invention.

The Examiner maintained his rejection of claim 21 regarding the indefiniteness of the term "peak". In order to avoid any further confusion, Applicant has deleted the term from the claim.

The Examiner has not presented any arguments to Applicant's response to the prior art rejections under 35 §102 and §103. Consideration of same is respectfully requested.

## CONCLUSION

The present response is intended to correspond with the Revised Amendment Format. Applicants understand that with the Revised Amendment Format, the provisions of 37 CFR §1.121 are waived. Should any part of the present response not be in full compliance with the requirements of the Revised Amendment Format, the Examiner is asked to contact the undersigned for immediate correction.

No new matter has been added by way of the aforementioned amendments. For the above reasons, Applicants respectfully submit that the application is in condition for allowance, and such allowance is herewith respectfully requested.

In the event that the transmittal form is separated from this document and the Patent Office determines that an extension of time and/or other relief is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees in connection with the filing of this document to Deposit Account No.: 502464 referencing client reference: 2001P80072WOUS. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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